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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,589	04/30/2001	Dale F. McIntyre	82466RLO	2441

7590 03/18/2002
Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,589

Applicant(s)

MCINTYRE ET AL.

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalisher ('932) in view of Smith ('573).

Kalisher discloses a method of arranging personalized images to a page and fixing them in a book comprising the steps of obtaining information from an individual, feeding the information into a computer, forming visual images on a medium, printing the images and adhesively fixing them to a page.

Regarding the specific arrangement and/or content of indicia (visual images of different characteristics of the same image, the images being a digital image, the characteristics including different sizes and colors, etc.) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of indicia having desired characteristics since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an

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individual with a specific type of scrapbook does not alter the functional relationship.

Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Kalisher discloses the claimed invention except for cutting the images from the medium.

Smith discloses printing a doll and accessory pieces on a planar material, cutting the pieces from the planar material and adhering the pieces to a panel.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kalisher's invention to include the step of cutting the pieces from the medium instead of peeling the pieces from the medium, as taught by Smith, as an alternative method for removing the images from the medium.

Note: Regarding sending the image over a communication channel to a service provider with instructions to the service provider such as through the Internet (claims 20-22) , it is notoriously well-known to receive and send images via communication channels such as the Internet for communicating information between different parties at remote locations. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kalisher's invention to include sending the images over a communication channel for disseminating and receiving information.

Response to Arguments

3. Applicant's arguments filed January 8, 2002, have been fully considered but they are not persuasive. The Examiner maintains the rejections as set forth above.

Applicant argues that neither Kalisher nor Smith disclose the use of digital images producing a series of digital images of different characteristics. While Kalisher and Smith do not explicitly disclose the use of digital images, the Examiner maintains that the type of indicia used (digital images) would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The Examiner maintains that the images being digital does not provide any functional relationship for the substrate (page of the scrapbook).

Applicant argues the use of *In re Gulack* as it pertains to the present invention. The applicant states that *In re Gulack* is concerned with the contents of printed subject matter on a substrate. The Examiner agrees. The applicant also states that the "present invention is concerned with arranging digital images onto a scrapbook, which is a physical thing and is not directed just to printed subject matter." The Examiner agrees that the scrapbook is a "physical thing"; however, the claimed limitation of the "digital images" is printed matter and, as previously stated, the Examiner asserts that the printed matter being digital images does not provide any type of functional relationship to the scrapbook.

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Applicant's argument with respect to *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 47 USPQ 2d 1596 (Fed. Cir.), *cert. Denied*, 119 S. Ct. 336 (1998) is unclear as it relates to the present invention and to the rejections of record. The Examiner has not rejected the claims under 35 USC 101 for lacking utility which was the basis of the rejections applied in the above cited case. The Examiner agrees that the present invention constitutes a useful, concrete and tangible result, the scrapbook. However, the indicia located in the scrapbook does not impart any novel or unobvious functional relationship required for patentability. The Examiner maintains that the type of image, whether it be digital, embossed, or the like, used in the scrapbook would depend on the intended purpose of the scrapbook as set forth by the end user.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

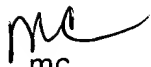
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


mc
March 11, 2002


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700